

### **REMARKS**

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated July 29, 2004 and phone conversation with the Examiner on October 20, 2004. Applicants thanks Examiner for taking the phone calls and providing the relevant information.

The Examiner pointed out that Kitagawa teaches an information display member (claim 1) as a poster, a signboard, or an ad hung down in trains were the "advertising medium" in Abstract and paragraph [0013], and the teaching for a signal member (claims 9-10) was the bar code which is a signal displayed by figures and can notify the existence of the information recording element.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

### **Status of the Claims**

Claims 1, 3-15, and 17-22 are under consideration in this application. Claims 2 and 16 are being cancelled without prejudice or disclaimer. Claims 1, 9-10, 17 and 20 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicants' invention. New claims are being added to recited other embodiments described in the specification.

### **Additional Amendments**

The claims are being amended to correct formal errors and/or to better disclose or describe the features of the present invention as claimed. All the amendments to the claims are supported by the specification. Applicants hereby submit that no new matter is being introduced into the application through the submission of this response.

### **Formality Rejection**

Claims 10 and 20 were objected due to minor informalities. As indicated, the claims have been amended as required by the Examiner. Accordingly, the withdrawal of the outstanding informality rejection is in order, and is therefore respectfully solicited.

### Allowable Subject Matter

Claims 11-12 and 19-20 were allowed.

### Prior Art Rejections

Claims 1-10, 13-15 and 18 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Application No. 2003/0120555 A1 of Kitagawa (hereinafter "Kitagawa"), and claims 16 and 17 were rejected under 35 U.S.C. §103 as being unpatentable over Kitagawa. The prior art references of US Application No. 2002/0046040 to Kirner and Japanese patent reference JP2002312269 to Oshida were cited as being pertinent to the present application. These rejections have been carefully considered, but are most respectfully traversed.

The system (Fig. 1) for reading display information according to the invention, as now recited in claim 1, comprises: an information display member *A*; and at least one mobile communication terminal (page 20, line 3-4) of a public mobile communication system *B* (e.g., a PDC, CDMA, or GMS system, page 21, lines 5 and 9, including at least one mobile phone) for reading at least a portion of the display information *G* (e.g., text, image, and audio page 16, last paragraph) displayed on said information display member *A*. The information display member comprises an information recording element *R* in which necessary and/or optional information of the information portion is stored; said mobile communication system *B* comprises a reader mechanism *V* for reading information recorded in said information recording element *R* and a display mechanism *E* for displaying the read information; and the information recorded in said information recording element *R* including said portion of the display information *G* displayed on said information display member *A*. The information display member *A* is a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue papers, an ad hung down in trains, or a mascot doll (page 15, lines 5-19). In particular, the information recording element *R* (1) includes an IC chip *S* having an antenna *U* for communicating with said mobile communication terminal (p. 11, 3<sup>rd</sup> paragraph; Fig.7; claim 1); or (2) a signal member *Z* carrying at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters for notifying an existence of said information recording element *R* (p. 27, 1<sup>st</sup> paragraph; Fig. 1).

The information display member physically displays information perceivable and desired by a person who would otherwise write down the information of interest on a memo pad (page 2, line 18) but for the availability of the invention.

As shown in Fig. 3, the information recorded in said reader mechanism is transferred

via a net line of a LAN (claim 4) to be recorded in a personal computer *I* or a server system *H* (Claim 5). The mobile communication system includes a mobile phone (Figs. 1 and 4; claim 13). The reader mechanism reads information from the information recording element in a contact or non-contact manner (Fig. 5; claim 14). The IC chip includes a coil antenna (page 11, line 13; Figs. 7 and 13; claims 16-17). The mobile communication system further comprises reading-out means for reading the text information into voice (page 26, 1<sup>st</sup> paragraph; claim 18) to serve blind people. The signal member *Z* carries at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters, e.g., *"Please put your mobile telephone close to posters. Our messages can be inputted to your mobile telephone"* (top of Fig. 3), in sound or characters, thereby announcing the existence of the information recording element *R*.

Applicants respectfully contend that neither Carayiannis nor any of the other cited reference or any combination thereof, teaches or suggests that the information recording element *R* on an information display member *A* includes (1) an IC chip *S* having an antenna *U* for communicating with said mobile communication terminal; or (2) a signal member *Z* carrying at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters for notifying an existence of said information recording element *R*.

Regarding feature (2), the bar code in Kitagawa simply does NOT carry at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters for notifying a person of the existence of the information recording element *R*.

Regarding (1) feature, as admitted by the Examiner, *"Kitagawa fails to teach or suggest an information recording element including an IC chip having a coil antenna"* (p. 5, last paragraph of the outstanding office action)."

Applicants respectfully contend that the Examiner's reliance upon the "common knowledge and common sense" of one skilled in the art for the motivation to substitute Kitagawa's bar code with an IC chip having an antenna or any attempt to substitute Kitagawa's bar code with an audio signal, an on-and-off light signal, or a signal displayed by characters falls far short of fulfilling the agency's obligation to cite references to support its conclusions by pointing out the specific teaching, e.g. *statements in the prior art*, of allegations of the combination on the record to allow accountability.

*To establish a prima facie case of obviousness, the Board must, inter alia, show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the*

relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *Kotzab*, 217 F.3d at 1370, 55 USPQ2d at 1317. .... Recently, in *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), we held that the Board’s reliance on “common knowledge and common sense” did not fulfill the agency’s obligation to cite references to support its conclusions. *Id.* at 1344, 61 USPQ2d at 1434. Instead, the Board must document its reasoning on the record to allow accountability. *Id.* at 1345, 61 USPQ2d at 1435.

See *In re Thrift*, 298 F.3d 1357.

Under the current case law and MPEP 2144.03, Applicants respectfully assert that the Examiner did not properly rely upon the knowledge of one skilled in the art only based upon concrete evidence in the record in support of the alleged knowledge of one skilled in the art of substituting Kitagawa’s bar code with an IC chip having an antenna or with an audio signal, an on-and-off light signal, or a signal displayed by characters. A bar code is merely a passive marking means, which does not actively transmitting data to a cell phone terminal or receiving data to be written therein as an IC chip having an antenna (“Data of the IC chip (S) inputted as described above is transmitted to an IC chip by using a known appropriate reader/writer.” P. 12, 2nd paragraph), or carry at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters for actively notifying an existence of said information recording element *R*.

Although the invention applies a general IC chip having an antenna or a general signal member, the invention applies the mechanism on a marketing information display member A such as a poster, a signboard, a time table, a statement of virtues, a paper ad, a postcard, a handbill, tissue papers, an ad hung down in trains, or a mascot doll to achieve unexpected results or properties. For example, to have two-way communication the marketing information stored in the chip and shown on the information display member. As another example, if only an on-and-off light signal or a signal displayed by characters is available, a signal member to be detected by a mobile phone via electric communication supplements the signal for a blind person to be notified of the existence of said information recording element *R*. As a third example, if only an audio signal is available, a signal member to be detected by

a mobile phone via electric communication supplements the audio signal for a deaf person to be notified of the existence of said information recording element *R*. The presence of these unexpected properties is evidence of nonobviousness. MPEP§716.02(a).

*“Presence of a property not possessed by the prior art is evidence of nonobviousness. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing " 'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' " ).*

Although “[t]he submission of evidence that a new product possesses unexpected properties does not necessarily require a conclusion that the claimed invention is nonobvious. *In re Payne*, 606 F.2d 303, 203 USPQ 245 (CCPA 1979). See the discussion of latent properties and additional advantages in MPEP § 2145,” the unexpected properties were unknown and non-inherent functions in view of Kitagawa, since Kitagawa does not inherently achieve the same results. In other words, these advantages would not flow naturally from following the teachings of Kitagawa, since Kitagawa fails to suggest (1) applying an IC chip having an antenna on a poster etc. for communicating with a cell phone terminal two-way marketing information stored in the chip and shown on the information display member, or (2) applying a signal member carrying at least one of an audio signal, an on-and-off light signal, and a signal displayed by characters for notifying an existence of said information recording element.

Applicants further contend that the mere fact that one of skill in the art could modify Kitagawa to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for one skilled in the art to provide the unexpected properties, such as applying IC chip having an antenna on a poster etc. for communicating with a cell phone terminal two-way marketing information stored in the chip and shown on the information display member, without the benefit of appellant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). MPEP§2144.04 VI C.

Applicants contend that neither Kitagawa, other cited references, nor their combination teaches or discloses each and every feature of the present invention as recited in independent claims 1 and 10. As such, the present invention as now claimed is distinguishable and thereby allowable over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

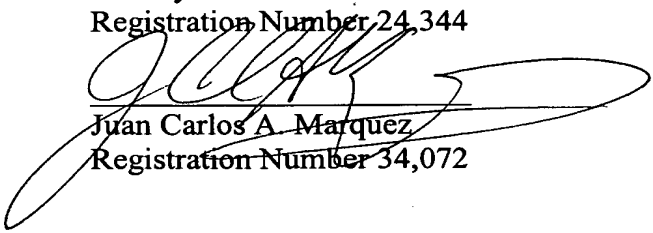
#### Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed in claim 1 and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicants' undersigned representative at the address and phone number indicated below.

Respectfully submitted,

\_\_\_\_\_  
Stanley P. Fisher  
Registration Number 24,344

  
\_\_\_\_\_  
Juan Carlos A. Marquez  
Registration Number 34,072

**REED SMITH LLP**  
3110 Fairview Park Drive, Suite 1400  
Falls Church, Virginia 22042  
(703) 641-4200

**November 29, 2004**

SPF/JCM/JT